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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,990	09/05/2003	Stanley Ho	794601-2093	7535

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EXAMINER

MARESCA, JOSEPH ANDREW

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/655,990	Applicant(s) HO, STANLEY	
	Examiner Joseph Maresca	Art Unit 2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-12-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: element 2 of Figure 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The error appears to be in the specification on page 6, line 13, where a second liquid is referred to as being element 3.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Computer Keyboard with Vessel Containing Two Liquids and a Decorative Element.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2675

5. Claims 5 and 14 recite the limitation "the decorative structure" in the first line of each of the claims. There is insufficient antecedent basis for this limitation in the claim. In claims 1 and 10 from which claims 5 and 14 depend respectively, there is claimed a decorative sealed vessel and at least one structure; however, there is no limitation set forth providing for proper antecedent basis for "the decorative structure" as stated in claims 5 and 14.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,380,926 in view of Lee (US Patent No. 6,697,051).

With respect to claim 8 of the present application, the claim corresponds to claim 8 of the '926 patent and only differs from the present application in that the decorative vessel is part of a computer pointer device instead of a keyboard device.

In the same field of endeavor (computer input devices), Lee teaches the use of a decorative sealed vessel in the use of a computer keyboard (column 4, lines 55-62). It is important to note that Lee makes reference to the '926 application in regards to his invention with a decorative structure (column 3, lines 18-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the decorative sealed vessel as originally claimed in the '926 patent and place it within

Art Unit: 2675

the housing of a computer keyboard as taught by Lee in order to provide a more attractive electronic device (in this case a keyboard) that has a decorative sealed vessel (column 1, lines 56-58).

With respect to claims 1 and 10 of the present application, these claims correspond to claim 1 of the '926 patent.

The first claim of the '926 patent is different from the claim in the present application in that the preamble discloses the decorative sealed vessel is a part of a computer pointer device.

In the same field of endeavor (computer input devices), Lee teaches the use of a decorative sealed vessel in the use of a computer keyboard (column 4, lines 55-62). It is important to note that Lee makes reference to the '926 application in regards to his invention with a decorative structure (column 3, lines 18-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the decorative sealed vessel as originally claimed in the '926 patent and place it within the housing of a computer keyboard as taught by Lee in order to provide a more attractive electronic device (in this case a keyboard) that has a decorative sealed vessel (column 1, lines 56-58).

With respect to claims 2 and 11 of the present application, these claims correspond to claim 2 of the '926 application.

Once again the '926 patent differs in the fact that the vessel is a part of the keyboard housing and not a part of a computer pointing device housing.

In the same field of endeavor (computer input devices), Lee teaches the use of a decorative sealed vessel in the use of a computer keyboard (column 4, lines 55-62). It is important to note that Lee makes reference to the '926 application in regards to his invention with a decorative structure (column 3, lines 18-22).

With respect to claims 3 and 12 of the present application, these claims correspond to claim 3 of the '926 patent which refers to the structure being a mouse. Since this structure as claimed has no effect on the operation of the computer input device it is inherent that its use must be decorative.

Art Unit: 2675

With respect to claims 4 and 13 of the present application, these claims correspond to any of claims 4-6 of the '926 patent. These limitations set forth replacing a button on the computer pointer device with a decorative sealed vessel and show that any of the buttons can be used.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the decorative sealed vessel as originally claimed in the '926 patent and place it within a key of the keyboard device as previously discussed in relation to Lee in order to provide a more attractive electronic device (in this case a keyboard) that has a decorative sealed vessel (column 1, lines 56-58).

With respect to claims 5 and 14 of the present invention, these claims correspond to claim 3 of the '926 patent, which differs in that it specifically claims the structure to resemble a mouse.

With respect to claims 6 and 15 of the present invention, these claims corresponds to claim 7 of the '926 patent.

With respect to claims 7 and 16 of the present invention, these claims correspond to claim 10 of the '926 patent.

With respect to claim 9 of the present invention, this claim corresponds to claim 8 of the '926 with respect to its dependency on claim 8 of the present invention. The aforementioned Lee, in regards to claim 8, teaches the keyboard device as a computer keyboard device.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (US Patent No. 6,697,051).

Art Unit: 2675

With respect to claim 8, Lee discloses at least one liquid (31 and 32), at least one structure (40, decorative structure), wherein the structure is insoluble in the liquid and floats on the liquid (column 3, lines 18-22), and wherein the decorative sealed vessel is an integral portion of the computer keyboard (column 4, lines 55-62).

With respect to claim 9, Lee further discloses the keyboard device (column 4, lines 55-62) is a computer keyboard. The fact that the keyboard is a computer keyboard is inherent from the disclosure of Lee in that the devices for which the decorative element are described are all computer hardware devices.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 6,886,022 to Lee which discloses a calculator device with a keypad that has a decorative structure within a enclosure similar to the claimed invention and the '051 patent used in the rejections.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Maresca whose telephone number is (571) 272-5517. The examiner can normally be reached on M-TH and alternate Fridays 7:15 am to 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAM

12/21/05

Joseph Maresca


KENT CHANG
PRIMARY EXAMINER